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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,246	08/16/1999	MANUEL PERUCHO	P-LJ-3597	4823

23601 7590 04/08/2002

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EXAMINER

SOUAYA, JEHANNE E

ART UNIT	PAPER NUMBER
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1634

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DATE MAILED: 04/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/375,246Applicant(s)
Perucho et al.Examiner
Jehanne SouayaArt Unit
1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Mar 22, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attachment

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).

6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: none

Claim(s) objected to: none

Claim(s) rejected: none

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.


10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☐ Other:

Attachment

The amendments after final rejection will not be entered because they raise new issues requiring further search and consideration. The response traverses that the amendments place the claims into condition for allowance or in better form for consideration on appeal and do not raise new issues for consideration. This argument has been thoroughly reviewed but was found unpersuasive because the claims in the amendment after-final do not place the claims in condition for allowance. The examiner did not specifically state or suggest that the claims as present in the amendments after final would be allowable. The response states that the claims have been amended to a form that the office action asserted to be enabled. This argument has been thoroughly reviewed but was not found persuasive. In replying to applicants previous arguments, the examiner summarized certain teachings in the specification, however these specific teachings (ie: to gains of chromosome 6 and losses of chromosomes 4 as prognostic for metastasis) were not evaluated in terms of being enabled as the claims under consideration were not drawn to such. Further, the examiner did not suggest that the claims would be enabled if they were amended in the present proposed format. The amendments have significantly changed the scope of the claims, not only regarding the amendments from "clinical outcome" to "risk of recurrence of colorectal cancer" or "likelihood for metastasis" or "prognosis for survival", but also with regard to chromosome 6 gains or chromosome 4 losses being prognostic of metastasis of colorectal cancer or loss of chromosome 4 being prognostic of poor survival. In addition to raising new issues under 35 USC 112/1st paragraph, the amendments after final would raise new issues under 35 USC 112/ 2nd paragraph.

Jehanne Souaya
Patent Examiner
4/2/02


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600